

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Handwritten notes: HAF, 4-29-04, mel

Re patent application:

Appl. No. : 09/703,231
Applicant : Leon A. Pintsov
Filed : October 31, 2000
Art Unit : 3621
Examiner : Le, David Q
Attorney Docket No. : F-224
Customer No. : 00919

Confirmation No.: 2617

RECEIVED

APR 15 2004

Technology Center 2600

Date: April 8, 2004

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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APPELLANT'S BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claims 24-32 of the above-identified application mailed August 18, 2003. The fee for submitting this Brief is \$330.00 (37 C.F.R. § 1.17(c)). Payment of the fee is provided in a separate Transmittal submitted herewith. The Notice of Appeal was received by the U.S. Patent and Trademark Office on January 22, 2004. A petition for a one month extension of time is included in the Transmittal. Enclosed with this original are two copies of this brief.

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04/14/2004 RMEBRAFT 00000092 161867 09703231

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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no related appeals or interferences that may have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 24-27, 29-32 stand rejected under 35 U.S.C. 102 (a) as being anticipated by Kara, PCT Publication WO 99/21330.

Claim 28 stands rejected under 35 U.S.C. 103 (a) as being unpatentable over Kara, PCT Publication WO 99/21330.

IV. Status of Amendments

There are no amendments to the claims filed subsequently to the final rejection of August 1, 2003. Therefore, the claims as set forth in Appendix A to this brief are those as set forth before the final rejection.

V. Summary of Invention

Appellant's invention relates to a method for sending an electronic message to the mailer of a mail piece upon delivery of the mail piece using information located at a predetermined location on a mail piece. The invention provides to the mailer an electronic response message composed by the recipient of the mail piece as part of a delivery confirmation when the mail piece is delivered. The electronic address of a mailer is included in a digital postmark printed on the mail piece or is printed directly on the mail piece. During the delivery of the mail piece, an electronic image of the mail piece is captured, and the mailer's address is captured. The electronic message, which includes the recipient response and may include the mail piece image

and a physical image of the recipient, is sent to the mailer in accordance with information obtained from the captured image of the mail piece.

The present invention furthers the invention that is disclosed in parent patent application, US Patent Application Serial Number 09/339,768, which has issued as US Patent No. 6,532,452. The '452 patent discloses including a mailer's e-mail address in the digital postmark for the purpose of sending the mailer an e-mail return receipt. The present invention goes beyond the '452 patent and provides an electronic response message composed by the recipient of the mail piece as part of a delivery confirmation when the mail piece is delivered.

The present invention provides the mailer with the ability to receive an image of a mail piece in addition to confirmation of receipt and provides the recipient, upon mail piece receipt, with the ability to submit a response to the original mailer at the time of receipt, in a secure manner. This invention integrates electronic communication information, such as an e-mail address or any other electronic address (for example, a facsimile number, separate e-mail address or pager number), into a conventional DPM, any other predetermined identifier, or the information may be printed directly on said mail piece in a predetermined location. The invention provides the creation and communication of messages between the mailer and the recipient. Personal response messages are communicated in a more expeditious and effective manner. An image of a mail item communication message can be included in an e-mail response to a special service request as an evidence of the nature of delivered message. These messages may be archived at the post office or a third party data center for future access. Through use of well-known security techniques, such as cryptography, the present invention deals effectively with issues of confidentiality, message integrity, authentication and non-repudiation. These and other aspects of the present invention are covered in the detailed description of the invention.

In accordance with the present invention Claim 24 provides a method for acknowledging the delivery of a mail piece within a mailing system. When a mail piece is delivered to a recipient of the mail piece an electronic image of the mail piece, an image of a recipient's signature and a response message composed by the recipient are captured. The captured images of the mail piece, the recipient's signature and the response message are combined to form an electronic message response acknowledging receipt of the mail piece.

Claims 25-32 depend on claim 24. According to claim 25, the electronic address of an originator of the mail piece is determined and the electronic message response is sent to the originator of the mail piece. Claim 26 provides that the electronic address of the originator is an e-mail address obtained by scanning the mail piece. According to claim 27, the steps of capturing the image of the recipient's signature and capturing the response message are performed with an electronic data collection device. According to Claim 28, the steps of capturing the image of the recipient's signature and capturing the response message include a further step of scanning a printed form containing the recipient's signature and response message to obtain an electronic image of the image of the recipient's signature and the response message. According to claim 29, the steps of determining the electronic address of the originator of the mail piece and sending the electronic message response to the originator of the mail piece are performed with the electronic data collection device. According to claim 30, the electronic message response is digitally signed and archived. According to claim 31, the step of capturing the response message is optional. Finally, claim 32 provides a determination that the originator of the mail piece has requested delivery confirmation.

Additional features of the invention are discussed below in the Argument section of this Brief.

VI. Issues

A. Whether the subject matter defined in claims 24-27, 29-32 are anticipated by Kara, PCT Publication WO 99/21330.

B. Whether the subject matter defined in claim 28 is anticipated by Kara, PCT Publication WO 99/21330.

VII. Grouping of Claims

Claims 24-32 stand or fall together.

VIII. Argument

As Appellant discusses in detail below, the final rejections of claims 24-32 are devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully

submitted that the rejections do not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellant is entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A. The claims 24-27, 29-32 are not anticipated by Pintsov '036.

Claims 24-27, 29-32 stand rejected under 35 U.S.C. 102 (a) as being anticipated by Kara, PCT Publication WO 99/21330. In paragraph 7 of the final Office Action, the Examiner supports the rejections by citing various excerpts from Kara for each of the elements of claims 24-27 and 29-32. Contrary to the Examiner's contentions, there is nothing in Kara that discloses or suggests the following elements from independent claim 24:

capturing a response message composed by the recipient when the mail piece is delivered; and

combining the captured electronic image of the mail piece, the captured image of the recipient's signature and the captured response message to form an electronic message response acknowledging receipt of the mail piece.

The present invention is directed to a method for providing a value added service associated with the delivery of a mail piece. The value added service is response message from the recipient of a mail piece to the originator of the mail piece that includes a scanned image of the mail piece, an image of the recipients signature indicating receipt of the mail piece and a personal message from the recipient created at the time of receipt of the mail piece.

Kara does not disclose or suggest combining a captured electronic image of the mail piece, a captured image of the recipient's signature at the time of delivery and a captured response message, which is composed by the recipient when the mail piece is delivered, to form an electronic message response acknowledging receipt of the mail piece. As evidenced by Figures 4 and 5 (the two flow charts describing the Kara invention) and the associated text, the system and method disclosed in Kara do not involve actions taking place at the time of delivery other than the actual delivery itself, i.e., no capturing of mailpiece image, recipients signature or a message composed by recipient.

As seen in Figure 1, Kara is directed to a system and method for transmission of a document from a sending location to a receiving location by way of a trusted way location. A document is physically or electronically transmitted by a sending location to a letter server operated by a delivery service. A confirmation of transmission of the document from the sending location to the trusted way location is provided to the sender by the delivery service. (See step 5009 in Fig 5.) Thereafter, the letter server reproduces the document in original quality, accompanied by any necessary items such as a delivery container and/or delivery instructions. The delivery service then delivers the reproduced document such as through electronic delivery or inducting the reproduced document into its delivery paradigm for physical delivery to the indicated recipient, i.e. the receiving location. (See the abstract and Figs. 4 and 5.) According to Kara, the document at some point in the process is in electronic form so that it can be transmitted to the letter server (101) as shown in Fig. 1. See page 7, first paragraph, where Kara provides the following.

However, it shall be appreciated that the present invention's electronic induction into the postal system at a point early in the paradigm and/or direct electronic delivery to the postal office nearest the recipient avoids the handling and transportation delays introduced in the above described posting of mail. According to the present invention, the document need only be sorted at the way location, i.e., the postal office, in order to be electronically inducted or be associated with the proper carrier to physically deliver the document. If proof of delivery is desired, such as through the use of a return receipt, or special delivery is required, such as registered delivery or expedited delivery, such can be noted at the time of receipt at the way location. Thereafter, the delivery of the document may be handled accordingly.

Referring to the Examiner's comments concerning the third element of claim 24, the Examiner contends that Kara (at page 27, lines 19-21 and page 37, lines 19-20) discloses capturing a response message composed by the recipient when the mail piece is delivered. With regard to the first citation, the Examiner has taken lines 19-21 out of context. The confirmation of transmission in Kara (page 27, lines 19-21) is not a message composed by the recipient but is merely a confirmation of successful transmission from the way location to the sending location, i.e., before the mail piece is sent to the recipient. Referring to lines 7-21 from page 27 (emphasis added):

Preferably, upon successful transmission of the document from the transmission location to the way location, confirmation of transmission is returned to the transmission location. Such confirmation may be in the form of a message confirming

the size and date/time of the transmission and may include information regarding the sender and/or receiver. Alternatively, such confirmation includes information from which the transmitted document may be recreated. For example, the confirmation may be a code, such as a two dimensional bar code, containing not only the above information, but also information from which the complete document may be later reproduced. Such information provides advantages to the present day return receipt commonly used in postal systems, as not only may the transmission of a document be confirmed, but so to may the contents of that document.

The confirmation of transmission by the present invention may be immediately returned electronically to the transmission site, such as through return FAX or a reverse channel signal communicated to a transmitting PC. Alternatively, the confirmation may be provided separately such as through a hard copy transmitted through a postal system.

With regard to the Examiner's reference to page 37, lines 19-20. Applicants set forth below lines 15-22 of page 37 (emphasis added) to show that there is no support for the Examiner's contention that this section of Kara discloses or suggests capturing a response message composed by the recipient when the mail piece is delivered.

Of course, regardless of establishing the correlation between the transmitted document and received document, the present invention may operate to provide **a receipt of actual delivery to the recipient** of the transmitted document to the sender. This **receipt** may be communicated to the sender along the reverse path of the transmission of the document by the sender or may be by a different path. This **receipt** may include an acknowledgment of delivery by the recipient. In the case of electronic transmission, this **acknowledgement may be in the form of a digital signature** provided by, or associated with, the aforementioned authentication information.

Although Kara discloses that a receipt of actual delivery may include an acknowledgement of delivery by the recipient, there is no disclosure or suggestion that such acknowledgement may be anything other than the signature of the recipient.

Referring to the Examiner's comments concerning the fourth element of claim 24, the Examiner contends that Kara (at page 37, lines 7-21) discloses combining the captured electronic image of the mail piece, the captured image of the recipient's signature and the captured response message to form an electronic message response acknowledging receipt of the mail piece. The Examiner is incorrect. Applicants submit that lines 7-14 (set forth below) are not related to the combination of captured images/messages to form an electronic message acknowledging receipt; but instead refers to authentication of the original document delivered through a trusted third party.

According to this preferred method a trusted third party, here the delivery service, confirms the correlation between the transmitted document and the received document (here the reproduction of the document). When confirmed, an indicia of certification is generated which may be attached to the document. This indicia may include such information as the sending party, the time the document was transmitted and a summary indication of the document's contents for later detection of authenticity of the contents. Alternatively, this indicia may actually include a coded version of the contents of the document for later reproduction.

Referring again to lines 15-21 of page 37 (set forth in the previous paragraph), contrary to the Examiner's contentions, Kara does not disclose or suggest capturing a response message composed by the recipient when the mail piece is delivered, nor does Kara disclose or suggest combining the captured electronic image of the mail piece, the captured image of the recipient's signature and the captured response message to form an electronic message response acknowledging receipt of the mail piece.

For at least the above reasons, Appellant respectfully submits that the final rejections as to claim 24 is in error and should be reversed. Claims 25-27 and 29-32 are dependent upon claim 24 and therefore the final rejection with respect to these claims should also be reversed.

B. Claim 28 is patentable over Kara, PCT Publication WO 99/21330.

Claim 28 stands rejected under 35 U.S.C. 103 (a) as being unpatentable over Kara, PCT Publication WO 99/21330. Claim 28 is dependent on claim 24. In paragraph 9 of the Office Action, the Examiner contends that Kara discloses all the limitations of claim 24 and acknowledges that Kara does not disclose scanning a printed form containing the recipient's signature and response message to obtain an electronic image of the image of the recipient's signature and the response message. The Examiner contends that Kara teaches that all well-known methods for (1) delivering a message to the intended recipient will be used and (2) evidence of such receipt will be captured, including recipient's signature using well-known methods. The Examiner cites several sections of Kara to support this contention.

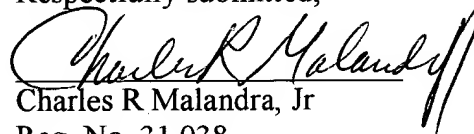
Applicant's response to this rejection is simple. As set forth above with regard to the 102(b) rejection, Kara does not teach or suggest the limitations of claim 24. Therefore, Kara does not teach or suggest the limitations of claim 28.

For at least the above reasons, Appellant respectfully submits that the final rejection as to claim 24 is in error and should be reversed. Claim 28 is dependent upon claim 24 and therefore the final rejection with respect to this claim should also be reversed.

IX. Conclusion

In Conclusion, Appellant respectfully submits that the final rejections of claims 24-32 are in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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APPENDIX A

24. A method for acknowledging the delivery of a mail piece within a mailing system, the method comprising the steps of:
- capturing an electronic image of the mail piece;
 - capturing an image of a recipient's signature when a mail piece is delivered to the recipient;
 - capturing a response message composed by the recipient when the mail piece is delivered; and
 - combining the captured electronic image of the mail piece, the captured image of the recipient's signature and the captured response message to form an electronic message response acknowledging receipt of the mail piece.
25. The method of claim 24 comprising the further steps of:
- determining an electronic address of an originator of the mail piece; and
 - sending the electronic message response to the originator of the mail piece.
26. The method of claim 25 wherein the electronic address of the originator is an e-mail address obtained by scanning the mail piece.
27. The method of claim 24 wherein the steps of capturing the image of the recipient's signature and capturing the response message are performed with an electronic data collection device.
28. The method of claim 24 wherein the steps of capturing the image of the recipient's signature and capturing the response message include a further step of:
- scanning a printed form containing the recipient's signature and response message to obtain an electronic image of the image of the recipient's signature and the response message.

29. The method of claim 26 wherein the steps of determining the electronic address of the originator of the mail piece and sending the electronic message response to the originator of the mail piece are performed with the electronic data collection device.
30. The method of claim 26 comprising the further steps of:
digitally signing the electronic message response; and
archiving the signed electronic message response.
31. The method of claim 24, wherein the step of capturing the response message is optional.
32. The method of claim 24 comprising the further step of:
determining that an originator of the mail piece has requested delivery confirmation.